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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,731	08/10/2001	Richard Allen Hayes	PT0043 US NA	7194

23906 7590 11/01/2002

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EXAMINER

ACQUAH, SAMUEL A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,731

Applicant(s)

HAYES ET AL.

Examiner

SAMUEL A. ACQUAH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-12 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Applicant's arguments filed 08/25/02 have been fully considered but they are not persuasive. See the following explanations.
3. Claims 1-4 and 6-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schade '262.

The cited prior art is of record in the previous communication. It is applicants' position that the cited prior art is different because it discloses a copolyester that is "water dispersible" while applicants claim a copolyester that is "solvent soluble", and that the reference **"fails to disclose a single teaching related to solvent soluble copolyesters, instead of focusing exclusively on water dispersible copolyesters, which are not the object of Applicants' claimed invention"**, (emphasis added).

It is the Examiner's position that Applicants' argument is not convincing, and in this regard, it is herein pointed out that of all the claims under rejection, only claim 11 recite solvent solubility. The remaining claims are completely silent as to solvent solubility; thus, Applicants are arguing a limitation that is not in the claims. Meanwhile, Applicants' attention is directed to column 1, lines 63-65, wherein patentee clearly discloses that "It would therefore become desirable to provide an improved **water-soluble**...polyester" (emphasis added). Applicants are reminded that "water" in that case is a solvent for the polyester. Thus, patentee **does** disclose a **solvent-soluble** polyester.

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Regarding Applicants' argument relating to molecular weight and IV, It is the Examiner's position that Applicants have only provided an opinionated argument, and have not provided any convincing evidence that the claimed IV would not be inherent in the prior art composition.

Regarding Applicants' argument that the prior art does not use aliphatic dicarboxylic acid in claim 3, and that claim 4 does not use IPA claimed, Applicants attention is herein directed to EXAMPLE 5 in column 7, which discloses the use of adipic acid, an aliphatic acid, and also IPS (isophthalic acid) in the amount of 23 mole percent in the composition. That composition clearly meets the requirements of the claims. Thus, based on Applicants' argument that Comparative Example CE 2 shows that using only 10 mole percent of isophthalic acid produces a polyester composition that is not solvent soluble, then patentees EXAMPLE 5 which includes 23 mole percent of isophthalic acid would provide a polyester that is solvent soluble. Based on Applicants' argument, it is now being pointed out that claim 6 which was previously objected to is now being rejected on the basis solubility in polar solvents would be inherent in the prior art copolyester.

4. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL A. ACQUAH whose telephone number is 703-308-2436. The examiner can normally be reached on M-TH, FRIDAYS OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES SEIDLECK can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-0661.

S.A.A.
October 30, 2002


SAMUEL A. ACQUAH
PRIMARY EXAMINER
GROUP 123 1700